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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 09/473,853

Filing Date: December 29, 1999

Appellant(s): LANIER ET AL.

MAILED

APR 07 2003

GROUP 3600

James N. Kallis
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 22, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 10-11 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,679,938

Templeton et al.

10-1997

Illinois Gaming Board Regulations, Title 86, Part 3000, Sections 700, 710, 720, 725, 730, 740 effective no later than April 1, 1997.

Two documents showing persons excluded from gaming in New Jersey for passing bad checks.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Templeton et al* in view of *Illinois Gaming Board Regulations*, hereinafter *Regulations*. This rejection is set forth in prior Office Action, Paper No. 8.

(11) *Response to Argument*

At page 4 of the Brief, first paragraph of "Argument", second and fourth items, Appellant raises the issue of expectation of success; no arguments are presented in the Brief regarding this topic. At the third item, Appellant refers to the need for teaching or suggestion of all claim limitations; no arguments are presented in the Brief regarding this topic.

As to Appellant's argument regarding the need for references to teach the source of a problem, *In re Kaslow* is quoted below:

OVERVIEW: Appellant applied for a patent for an invention related to a method and system for redeeming discount coupons automatically at a retail store's checkout counter. Intervenor had previously adopted a similar system, but failed to adopt the use of its system on coupons as of the effective date of appellant's application. Appellant's patent application was rejected by the Patent and Trademark Office Board of Appeals (Board) as obvious, under 35 U.S.C.S. 103, and as being drawn to new matter under 35 U.S.C.S. § 132. *The court agreed with the Board that appellant's specification did not support the argument that he discovered the source of the problem of retailer fraud. The court also found that appellant's claimed invention as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.* (Italics added).

Appellant has not argued that she recognized the source of a problem. Appellant's specification makes no reference to recognizing the source of a problem. The citation of the case law and arguments on the topic of source recognition at pages 8-9 do not support Appellant's arguments regarding unobviousness.

Additionally, Appellant fails to specify what the recognized problem source was.

At sections 1-3 of Arguments, Appellant discusses Background, the Claimed Invention and the Prior Art of Record. The Examiner is in agreement with these comments.

Appellant begins substantive argument at section 4. Appellant first argues at the bottom of page 8 of the Brief, that Templeton and Regulations do not teach the source of the problem of exclusion and cashing good checks. Appellant fails to make clear in the Brief, what she considers to be such a source of the problem or what specifically the references lack. Appellant describes the problem at pages 8-9 but makes no comment on the source. The Examiner agrees that the obvious combination of Templeton and Regulations provides the all elements of Appellant's claimed invention. In response to Appellant's argument that the combination of Templeton and Regulations was made using improper hindsight, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's arguments at page 9 against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellant admits that both the references teach processing of information for exclusion lists; information for such lists would be

similar. Further, Appellant concludes by saying that the references contain no suggestion of combination. Appellant argues that each reference fails to teach a feature. The Examiner relied on each teaching for what they teach and what one of ordinary skill in the art would have inferred from their possible combination. The test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

At page 10 of the Brief, Appellant draws attention away from the fact that Mr. DeSimone also was indicted for uttering counter checks (checks to purchase chips) knowing that they would be dishonored. Such uttering provides a nexus between the need to identify a person using Templeton and to use Regulation's identification to exclude a person from a gambling establishment.

At the second and third full paragraphs of page 10, Appellant argues against motivation to combine by arguing the references piecemeal, Appellant fails to recognize what the references would suggest to one of ordinary skill in the art. Specifically, the combination of Templeton and Regulations would be obvious because:

- 1) Templeton discloses a method for providing identification information about a person within a method of detecting bad checks.
- 2) Regulations discloses a need to identify persons to be excluded from gambling establishments for, among other things, passing bad checks. See Regulations, page 3, item c). Passing bad checks would inherently be an act of notorious or unsavory reputation, which would affect public confidence and trust in Gaming. The information for such identification would be similar to if not identical for the two references.

3) The combination of Templeton and Regulations would have been obvious because it would have provided identification of persons on an exclusion list who might adversely affect public confidence and trust in gaming and cause them to be excluded from the gaming premises.

The document related to Mr. DeSimone clearly shows that he should be excluded (he is on such a list) and that he has passed bad checks (highlighted words). Templeton provides a method to identify a person, whether passing good or bad checks; identification of the person using information of Templeton for exclusion from a casino would be obvious because of the common identification information.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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March 31, 2003

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